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TRANSCRIPT OF RECORD
IN THREE VOLUMES

IN THE

Supreme Court of the United States

October Term, 1953

No. [redacted].59

PACIFIC CONTACT LABORATORIES, INC., MORRIS GREEN and LEE W. HOGGAN,

Petitioners,

vs.

SOLEX LABORATORIES, INC.,

Respondent.

Volume III
(Pages 269 to 283)

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

Phillips & Van Orden Co., 870 Brannan Street, San Francisco, Calif.—4-16-54

No. 13333

United States Court of Appeals

For the Ninth Circuit

PACIFIC CONTACT LABORATORIES, INC., MORRIS GREEN and LEE W. HOGGAN,

Appellants,

vs.

SOLEX LABORATORIES, INC.,

Appellee.

Appeal from the United States District Court for the Southern District of California, Central Division.

Proceedings Had in the United States Court of Appeals for the Ninth Circuit

Phillips & Van Orden Co., 870 Brannan Street, San Francisco, Calif.

United States Court of Appeals
for the Ninth Circuit

Excerpt from Proceedings of Tuesday, October 27, 1953.

Before: Stephens, Orr and Pope,
Circuit Judges.

[Title of Cause.]

ORDER OF SUBMISSION

Ordered appeal herein argued by Mr. Collins Mason, counsel for appellant, and by Mr. Fred H. Miller, counsel for appellee, and submitted to the court for consideration and decision.

United States Court of Appeals
for the Ninth Circuit

Excerpt from Proceedings of Wednesday, December 9, 1953.

Before: Stephens, Orr and Pope,
Circuit Judges.

[Title of Cause.]

ORDER DIRECTING FILING OF OPINION AND FILING AND RECORDING OF JUDGMENT

Ordered that the typewritten opinion this day rendered by this court in above cause be forthwith filed by the clerk, and that a judgment be filed and recorded in the minutes of this court in accordance with the opinion rendered.

United States Court of Appeals
for the Ninth Circuit

No. 13,333

PACIFIC CONTACT LABORATORIES, INC., MORRIS GREEN and LEE W. HOGGAN,

Appellants,

vs.

SOLEX LABORATORIES, INC.,

Appellee.

Dec. 9, 1953

Appeal from the United States District Court for the Southern District of California, Central Division

OPINION

Before: Stephens, Orr and Pope, Circuit Judges.

Stephens, Circuit Judge.

Solex Laboratories, Inc., as the assignee of Kevin M. Tuohy, was issued Patent No. 2,510,438 on June 6, 1950. The patent claims a contact vision corrective lens which fits on the cornea[1] of the eye.

Contact lenses are admittedly old in the art of vision correction. However, the contact lenses in general use prior to the Tuohy patent were shaped

[1]The transparent outer coat of the eyeball that covers the colored iris and the pupil. Its extension over the white of the eye is known as the sclera.

to the identical curvature of the fitted eye and were held in place by the use of scleral flanges that extended over the white of the eye and under the eyelids.[2] Their design cut off the flow of natural fluids, blood and oxygen to the eye. Therefore, the use of contact lenses required the insertion of a buffer solution between the eye and the lens. The buffer solution had to be specially prepared for each person and even with its use, the lenses could be worn for an average of only four hours.

Tuohy's claim of invention lay in the development of a contact lens which eliminated the need for buffer solutions and which could be worn for long periods without causing eye irritation. Tuohy accomplished this result by eliminating the scleral flanges and making a lens slightly smaller than the limbus[3] portion of the eye, but larger than the maximum opening of the iris and by making the radius of curvature on the concave side of the lens slightly greater than the radius of curvature of the eye at the cornea[4] upon which the lens rests, thus enabling the natural fluids to reach all portions of the eye. The lens has less curvature than that of the eye and rests on the cornea only at its center point. Yet the lens remains in place, probably through capil-

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[2]See, e.g., Volle Patent No. 722,059, issued March 3, 1903.

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[3]The circular protruding margin between the iris and the white of the eye or the sclera.

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[4]See footnote 1.

lary action, and by the slight protrusion of the limbus; and any tendency on the part of the lens to slip off the apex of the cornea can be countered by blinking the eyelids. The inside marginal edge of the lens is beveled both for smoothing and to enable the lens to pass over the raised limbus.

Solex markets its lens under the name "Corneal" or "Tuohy Corneal." In June, 1950, after receiving its patent, Solex notified Dr. Morris Green (party defendant) that the contact lens which he was selling infringed Solex's newly acquired patent. Dr. Green nevertheless continued his activities and on October 25, 1950, Solex filed suit praying that Dr. Green, and Pacific Contact Laboratories, Inc., which is under his control, and Lee W. Hoggan, who is the manager of Pacific Contact Laboratories, Inc., be enjoined from infringing Solex's patent and from using the "deceptively similar name 'Cornea.'" Solex further sought an accounting for profits and damages, plus costs and a reasonable attorney's fee.

The district court found the patent valid and infringed, and that defendants' use of the the words "Cornea" and "Corneal" amounted to unfair competition with Solex's use of the words "Corneal Lens" and "Tuohy Corneal Lens." The defendants were enjoined on both counts and Solex was awarded damages in the amount of $5.00 per pair of contact lenses sold[5] by defendants, plus costs, and $500.00 as attorney's fees. Defendants appealed.

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[5]$575.00 total.

Appellants challenge the validity of Patent No. 2,510,438 on four separate grounds, namely: (1) Tuohy did not invent the corneal type contact lens; (2) The Corneal type contact lens claimed by Touhy lacks any "flash of creative genius";[6] (3) The claims do not describe the alleged invention in a clear and definite manner;[7] (4) The Tuohy patent is at best a "method" patent and as such cannot be protected by an "article" patent.[8]

The district court concluded that the patent was valid as to each of the two claims made,[9] and we

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[6]Cuno Engineering Corp. v. Automatic Devices Corp., 1941, 314 U. S. 84, 91.

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[7]Title 35 U.S.C.A. §33.

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[8]Citing Nestle-Le Mur Co. v. Eugene, 6 Cir., 1932, 55 F.2d 854.

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[9]Record on Appeal, p. 243: Patent No. 2,510,438: Claim 1: "A contact lens applicable to the human eye comprising a concavo-convex lens formed of light-transmitting material having a marginal size smaller than the limbus portion of the eye to which it is applicable but larger than the maximum iris opening, said lens having a radius of curvature on its concave side slightly greater than the radius of curvature of the cornea to which it is applied so that radially from the center of the lens there will be a small but gradually increasing clearance for the entry of natural eye fluids between the lens and the cornea, said lens being ground to correct for visual deficiency." Claim 2: "A contact lens applicable to the human eye comprising a concavo-convex lens formed of light-transmitting material having a marginal size smaller than the limbus portion of the eye to which it is applicable but

may not disturb the court's conclusion since it is supported by findings of fact which we do not regard as clearly erroneous[10] for the reasons hereinafter stated.

Did Tuohy Invent the Corneal Type Lens

Appellants contend that the corneal contact lens was anticipated by an invention of E. Kalt as disclosed in 1942 in the book "Contact Lenses" by Obrig,[11] which was admitted into evidence. Kalt's development was described in the Obrig book as follows:

> "He [Kalt] ground some small lenses to correct keratoconus[12] which had no scleral band, and

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larger than the maximum iris opening, said lens having a radius of curvature on its concave side slightly greater than the radius of curvature of the cornea to which it is applied so that radially from the center of the lens there will be a small but gradually increasing clearance for the entry of natural eye fluids between the lens and the cornea, said lens being ground to correct for visual deficiency and having a bevel at its marginal edges on the concave side thereof."

[10]Rule 52(a), Federal Rules of Civil procedure, Title 28 U.S.C.A.; United States v. United States Gypsum Co., 1948, 333 U. S. 364; Refrigeration Engineering v. York Corp., 9 Cir., 1948, 168 F.2d 896, 899.

[11]Published by Chilton Co., Philadelphia, Pa., 1942; pages 370 to 373 and 129 and 130.

[12]Keratoconus: conical protrusion of the cornea.

rested at the edge of the cornea. They were designed to exert some pressure on the apex of the conus in an attempt to reduce the ecstasia as well as to correct the visual error. As might be expected, they were unsuccessful."

The Patent Office issued Patent No. 2,510,438 with knowledge of the Kalt lens and the Obrig book. The district court considered the Kalt lens and rejected it as an anticipation. The quotation itself shows both that the objective which Kalt sought to reach was different from Tuohy's objective and that the Kalt lens was unsuccessful. If a prior art device is adaptable to a purpose, but it is not so adapted, that is evidence that the changes required more than mere mechanical skill and may support a conclusion of no anticipation.[13] And a prior unsuccessful experiment does not constitute invention and cannot therefore be an anticipation.[14]

It must also be noted that the Patent Office, only after making a close examination of Tuohy's claim of invention, granted him a patent on the corneal type lens. And there is evidence that the corneal lens met with wide acceptance and success only after Tuohy put it on the market. We, therefore, conclude that the district court's finding that Tuohy

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[13]Trabon Engineering Corp. v. Dirkes, 6 Cir., 1943, 136 F.2d 24. See, also, Motor Improvements v. General Motors Corp., 1931, 6 Cir., 49 F.2d 543.

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[14]Seymour v. Osborne, 1870, 78 U. S. 516, 552; The Corn Planter Patent, 1874, 90 U. S. 181, 210, 211.

invented the corneal type lens is not clearly erroneous.

"Flash of Creative Genius"

The Supreme Court in Cuno Engineering Corp. v. Automatic Devices Corp., 1941, 314 U. S. 84, 91, set forth the following tests for a patentable device:

> "* * * the new device, however useful it may be, must reveal the flash of creative genius, not merely the skill of the calling. If it fails, it has not established its right to a private grant on the public domain."

However, on July 19, 1952, as part of the revision of Title 35 U.S.C.A. on Patents, 66 Stat. 792, Congress enacted §103 which provides in part that,

> "Patentability shall not be negatived by the manner in which the invention was made."

The Reviser's note interprets this sentence to mean "that patentability as to this requirement [i.e., invention] is not to be negatived by the manner in which the invention was made, that is, it is immaterial whether it resulted from long toil and experimentation or from a *flash of genius* [italics ours]." That is, as we understand it, the Congress by enacting §103 showed its fear that the meaning of the phrase "flash of creative genius" as used by the Supreme Court in Cuno Engineering Corp. v. Automatic Devices Corp., supra, would result in excluding from patentability most if not all mechanical advances derived from study and experi-

mentation. We do not think the phrase "flash of creative genius" implies, or was intended to imply, that patents or patentability spring from inspiration at the cost of reason. The phrase was used more for emphasis than as patent dogma, and the Supreme Court was emphasizing the principle that patentability implies more than mere mechanical skill and that a phase of discovery is necessary. The opinion in which the phrase is used did not change the law. But should it be held otherwise, then the new law created by it brought no change as to the instant case, for we are dealing with an unexpired patent and §4(a) of the revised Act (inclusive of §103) contains the provision that the terms of the new Act "* * * shall apply to unexpired patents granted prior to such [effective] date [of the revised Act]," with certain exceptions not here pertinent. Thus, the phrase "flash of creative genius," as Congress understood it, was emasculated as to the validity of existing unexpired patents and made wholly ineffective as to future patents.

The district court could not well say that the development of a lens, which utilizes the limbus and capillary action to retain its position and which is so shaped as to utilize the natural fluids of the eyes to avoid irritation, is the result of mere mechanical skill. There is present, also, an idea in advance of the art to which mechanical skill of high order was applied. There is no clear error in the conclusion of the Patent Office and of the district court that this lens is a patentable invention.

Appellants raise two defenses not raised in the

district court, to wit: That there was no adequate description of the alleged invention filed in the Patent Office, and that the alleged invention is for a "method" rather than for an "article." In reply, appellee urges the well known principle that objections not made before the trial court cannot be raised here on appeal.[14a] Whether we could consider either of these questions sua sponte, we need not and do not decide, for when laid by the side of a statement of the case they are more pointlessly technical than meritorious.

Attorney's Fees

The district court awarded appellee reasonable attorney's fees. In doing so, the court exercised the discretion conferred upon it by Congress.[15] Appellants contend that the award of fees was an abuse of that discretion, since appellants' action in copying the Tuohy lens did not amount to "wilful conduct or bad faith." Citing Dubil v. Rayford Camp Co., 9 Cir., 1950, 184 F.2d 899. Appellants' lens is a "Chinese" copy of the Tuohy lens. Appellants' de-

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[14a]See Rule 12(h), Federal Rules of Civil Procedure, Title 28 U.S.C.A.; Baker v. Dean, 9 Cir., 1935, 80 F.2d 658, 660; Oxnard Canners, Inc., v. Bradley, 9 Cir., 1952, 194 F.2d 655, 659; Patent and Licensing Corp. v. Olsen, 2 Cir., 1951, 188 F.2d 522, 525; but cf. Nachman Spring-Filled Corp. v. Kay Mfg. Co., 2 Cir., 1943, 139 F.2d 781, 783.

[15]Title 35 U.S.C.A. §70, "* * * The court may in its discretion award reasonable attorney's fees to the prevailing party upon the entry of judgment on any patent case." Cf. new §285.

fense was that the Tuohy lens was not patentable. The district court found upon substantial and convincing evidence that the Tuohy lens was patentable and concluded that appellants' infringement was "both deliberate and wilful." We hold that the district court did not abuse its discretion in awarding attorney's fees in this case.

Motion for New Trial

Appellant's motion for a new trial upon the ground of newly discovered evidence was denied by the district court for lack of diligence. The motion is directed to the sound discretion of the trial court and is not ordinarily reviewable except where that discretion has been abused.[15a] We do not find such abuse here. Over seven months had elapsed between the filing of the action and the date of trial, and another four months elapsed prior to judgment, without the production of new evidence. Indeed, new evidence was not offered until after new counsel had been substituted by appellants at a time when, as the district court pointed out, appellants had already had their day in court. Furthermore, the alleged new evidence consists of an affidavit of a doctor who used a corneal type lens, which from its description in the affidavit may be similar to the article in suit, for eye operations from 1932 to 1937, together with an article in a professional publication which refers to unsuccessful experimenta-

[15a] Montgomery Ward & Co. v. Duncan, 1940, 311 U. S. 243, 253, 254; Marshall's U. S. Auto Supply v. Cashman, 10 Cir., 1940, 111 F.2d 140, 141.

tion with the corneal type lens. So long as the prior public use of an invention is experimental, it will not defeat the validity of a patent. Research Products Co. v. Tretolite Co., 9 Cir., 1939, 106 F.2d 530, 534-5.

Unfair Competition

Appellants have been enjoined from marketing infringing lenses under the terms "Corneal" and "Cornea." The district court holds the use of those terms by appellants to be unfair competition with appellee's designation of its lens as "Corneal" or "Tuohy Corneal." In order to prove a claim of unfair competition, "it is necessary to establish [among other things] that the name or appearance of the injured product has acquired either a technical trade-mark or a secondary meaning * * *." Ross-Whitney Corp. v. Smith, Kline and French Laboratories, 9 Cir., 1953, 207 F.2d 190.[16] There is no showing that "Corneal" has yet acquired a secondary meaning. There is no evidence that appellants ever used the name "Tuohy Corneal." Therefore, unfair competition has not been established.

Appellee's petition for reasonable attorney's fees on appeal are allowed in the sum of Two Hundred Fifty Dollars ($250.00) and appellee shall recover his costs.

Affirmed as to the finding of patent infringement, and reversed as to the finding of unfair competition.

[Endorsed]: Opinion. Filed Dec. 9, 1953. Paul P. O'Brien, Clerk.

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[16]See 150 A.L.R.(n) 1067, 1075 et seq.

United States Court of Appeals
for the Ninth Circuit

No. 13,333

PACIFIC CONTACT LABORATORIES, INC., MORRIS GREEN and LEE W. HOGGAN,

Appellants,

vs.

SOLEX LABORATORIES, INC.,

Appellee.

JUDGMENT

Appeal from the United States District Court for the Southern District of California, Central Division.

This Cause came on to be heard on the Transcript of the Record from the United States District Court for the Southern District of California, Central Division, and was duly submitted.

On Consideration Whereof, It is now here ordered and adjudged by this Court, that the judgment of the said District Court in this Cause be, and hereby is affirmed as to the finding of patent infringement, and reversed as to the finding of unfair competition, with costs in favor of the Appellee and against the Appellant.

It Is Further Ordered and adjudged by this Court that Appellee's petition for reasonable attorney's fees on appeal be, and hereby is allowed in the sum of $250.00.

Filed and entered December 9, 1953.

United States Court of Appeals
for the Ninth Circuit

Excerpt from Proceedings of Friday, February 19, 1954.

Before: Stephens, Orr and Pope,
Circuit Judges.

[Title of Cause.]

ORDER DENYING PETITION FOR REHEARING

On consideration thereof, and by direction of the Court, It is Ordered that the petition of Appellants, filed January 7, 1954, and within time allowed therefor by rule of Court for a rehearing in the above cause be, and hereby is denied.

United States Court of Appeals
for the Ninth Circuit

CERTIFICATE OF CLERK, U. S. COURT OF APPEALS FOR THE NINTH CIRCUIT, TO RECORD CERTIFIED UNDER RULE 38 OF THE REVISED RULES OF THE SUPREME COURT OF THE UNITED STATES

I, Paul P. O'Brien, as Clerk of the United States Court of Appeals for the Ninth Circuit, do hereby certify the foregoing 282 pages, numbered from and including 1 to and including 282, to be a full, true and correct copy of the entire record, excluding original exhibits, of the above-entitled case in the said Court of Appeals, made pursuant to request of counsel for the appellants, and certified under Rule 38 of the Revised Rules of the Supreme Court of the United States, as the originals thereof remain on file and appear of record in my office.

Attest my hand and the seal of the said the United States Court of Appeals for the Ninth Circuit, at the City of San Francisco, in the State of California, this 12th day of April, 1954.

[Seal] PAUL P. O'BRIEN,
Clerk.

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IN THE

Supreme Court of the United States

October Term, 1953

No. .....

PACIFIC CONTACT LABORATORIES, INC., MORRIS GREEN, and LEE W. HOGGAN,

Petitioners,

vs.

SOLEX LABORATORIES, INC.,

Respondent.

Petition for Writ of Certiorari to the United States Court of Appeals for the Ninth Judicial Circuit.

To the Honorable the Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioners, Pacific Contact Laboratories, Inc., Morris Green, and Lee W. Hoggan, defendants-appellants below in a patent infringement action, respectfully pray that a writ of certiorari issue to the United States Court of Appeals for the Ninth Circuit to review a judgment of that Court entered on December 9, 1953 [R. 281] holding valid and infringed the two claims of United States Letters Patent 2,510,438 [R. 239].

In the District Court, judgment was entered December 7, 1951 [R. 21], motion for a new trial was filed on December 17, 1951 [R. 24] and was denied on January 3, 1952 [R. 39]; and in the Court of Appeals petition for rehearing was filed January 7, 1954 [R. 282] and was denied on February 19, 1954 [R. 282].

The opinion of the Court of Appeals [R. 270] appears at 209 F. 2d 529.

Jurisdiction.

The jurisdiction of this Court is invoked under 28 U. S. C. Section 1254 and 15 U. S. C. Section 1122.

Statement of Case.

The Tuohy patent in suit, No. 2,510,438, relates to contact lenses to be worn on the eye to correct errors in vision.

Contact lenses consist of concavo-convex, or dish-shaped, pieces of transparent glass or plastic worn in direct contact with the eye. They are of two types: the "scleral" type and the "corneal" type, which differ from each other only in that the corneal type covers only the cornea of the eye, while the scleral type has a portion which covers the cornea and also has a flange or band portion which covers the scleral portion or "white" of the eye. The Tuohy patent relates to the corneal type.

The file wrapper of the Tuohy patent, Exhibit 2, shows that, when Mr. Tuohy filed his patent application, he made broad claims to having originated the corneal type lens.

The commissioner of Patents rejected those claims upon prior art and suggested that, if Mr. Tuohy had invented anything, it was a *method* of fitting a corneal type lens on the eye of the user. Mr. Tuohy then canceled his original claims and introduced the two claims of the patent in suit.

Although those two claims purport to be *article* claims, they describe the article in terms of the mode or method of fitting it on the eye of the user.

In the trial court, petitioners based their defense upon the contention that the patent was invalid for lack of invention over the prior art, which defense the trial court rejected. On appeal the Court of Appeals affirmed the judgment.

On appeal, however, petitioners urged the additional defense that, upon its face, the Tuohy patent is invalid because it describes the article which it seeks to monopolize in terms of the mode or method of its use. This latter defense was not urged in the trial court.

On appeal, respondent urged that the Court of Appeals could not consider the additional defense because it was not raised in the trial court. In its opinion, the Court of Appeals declined to rule as to whether or not it could consider the additional defense *sua sponte,* and merely dismissed it with the comment that it was "pointlessly technical".

Reasons Relied Upon for Issuance of Writ.

Petitioners respectfully submit that the writ should be issued because this Court has held uniformly in like cases that the infirmity appearing upon the face of this patent renders it invalid,[1] and the refusal of the Court of Appeals to consider and determine the infirmity is, according to the decisions of this Court,[2] contrary to public interest, although there are conflicting decisions of the lower Courts of Appeal as to their rights to consider defenses not urged before the trial court.

Questions Presented by This Petition.

The following questions are presented by this petition:

1. May and should not a Court of Appeals consider on appeal a serious infirmity appearing upon the face of a patent sued upon, even though the infirmity was not urged as a defense in the trial court?

2. Is an article patent invalid if its claims describe the article in terms of its mode or method of use?

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[1] *Muncie Gear Works v. Outboard M. & Mfg. Co.*, 315 U. S. 759, 86 L. Ed. 1171, 1178.

[2] *Holland Furniture Co. v. Perkins Glue Co.*, 277 U. S. 245, 72 Ed. 868, 873-874; *General Electric Co. v. Wabash Appliance Co.*, 304 U. S. 364, 82 L. Ed. 1402, 1406-1407.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

I.

Public Policy Requires That a Court of Appeals Consider and Determine a Serious Infirmity Appearing Upon the Face of a Patent in Suit, Even Though the Infirmity Was Not Urged as a Defense in the Trial Court.

> "We think the conclusion is inescapable that there was public use, or sale, of devices embodying the asserted invention, more than two years before it was first presented to the Patent Office. We are not foreclosed from a decision under Sec. 4886 on the point by the obscurity of its presentation in the courts below. This issue has been fully presented to this Court by the petition for a writ of certiorari, and in subsequent briefs and argument; and there is not the slightest indication that respondents have been prejudiced by such obscurity. To sustain the claims in question upon the established and admitted facts would require a plain disregard of the public interest sought to be safeguarded by the patent statutes, and so frequently presented but so seldom adequately represented in patent litigation."
>
> *Muncie Gear Works v. Outboard, M. & Mfg. Co.*, 315 U. S. 759, 86 L. Ed. 1171, 1178.

However, there appears to be diversity of opinion on this doctrine in the lower courts, as shown by the conflicting opinions in *Baker v. Dean* (9th Cir.), 8 F. 2d 658, 660; and *Nachman Spring-Filled Corp. v. Kay Mfg. Co.* (2 Cir.), 139 F. 2d 781, 783.

II.

The Two Claims of the Patent in Suit, No. 2,510,438, Define the Alleged Novelty of the Patented Article in Functional Terms of Its Mode of Use.

This is shown by the italicized portion of claim 1 of the patent quoted below:

> "1. A contact lens applicable to the human eye comprising a concavo-convex lens formed of light-transmitting material *having a marginal size smaller than the limbus portion of the eye to which it is applicable but larger than the maximum iris opening, said lens having a radius of curvature on its concave side slightly greater than the radius of curvature of the cornea to which it is applied so that radially from the center of the lens there will be a small but gradually increasing clearance for the entry of natural eye fluids between the lens and the cornea,* said lens being ground to correct for visual deficiency."

Seldom are two corneas found which are alike in size and curvature, and it would be obviously impossible for a lens manufacturer to know precisely how an optometrist might fit the manufacturer's lens upon a patient, and the patent statute does not impose any such burden upon a manufacturer.

Claim 2 of the patent has the same infirmity as claim 1.

III.

A Patent for an Article or Device Is Invalid if Its Claims Define the Scope of the Patent Monopoly in Terms of the Function of the Article.

"The Court of Appeals for the Ninth Circuit relied on the fact that the description in the claims is not 'wholly' functional. 80 F. 2d 958, 963. But the vice of a functional claim exists not only when a claim is 'wholly' functional, if that is ever true, but also when inventor is painstaking when he recites what has already been seen, and then uses conveniently functional language at the exact point of novelty. A limited use of terms of effect or result, which accurately define the essential qualities of a product to one skilled in the art, may in some instances be permissible and even desirable, but a characteristic essential to novelty may not be distinguished from the old art solely by its tendency to remedy the problems in the art met by the patent. . . . The Circuit Court of Appeals below suggested that 'in view of the difficulty, if not impossibility, of describing adequately a number of microscopic and heterogeneous shapes of crystals, it may be that Pacz made the best disclosure possible, . . .' But Congress requires, for the protection of the public, that the inventor set out a definite limitation of his patent; that condition must be satisfied before the monopoly is granted."

General Electric Co. v. Wabash Appliance Co., 304 U. S. 364, 82 L. Ed. 1402, 1406-1407.

IV.

Where an Invention Comes Within the Category of an Article or Device, the Patentee Must Claim It as Such and May Not Validly Claim Its Mode of Use.

". . . The attempt to broaden product claims by describing the product exclusively in terms of its use or function is subject to the same vice as is the attempt to describe a patentable device or machine in terms of its function."

Holland Furniture Co. v. Perkins Glue Co., 277 U. S. 245, 72 L. Ed. 868, 873-874.

See, also:

Burr v. Duryee, 1 Wall. 531, 17 L. Ed. 650;

Nestle-LeMur Co. v. Eugene (6 Cir.), 55 F. 2d 284.

Wherefore, petitioners pray that the writ be granted.

Dated: April 27, 1954.

Respectfully submitted,

COLLINS MASON,

Attorney for Petitioners.

State of California, County of Los Angeles—ss.

COLLINS MASON, being first duly sworn, deposes and says, that he is the atorney for the petitioner named in the foregoing Petition for Writ of Certiorari; that he has read the foregoing Petition for Writ of Certiorari and knows the contents thereof; and that the same is true of his own knowledge except as to the matters which are therein stated upon his information or belief, and as to those matters, that he believes them to be true.

COLLINS MASON

Subscribed and sworn to before me this 27th day of April, 1954.

(Seal) OPAL M. BURROWS,
Notary Public in and for the County of Los Angeles, State of California.

My commission expires Mar. 29, 1957.

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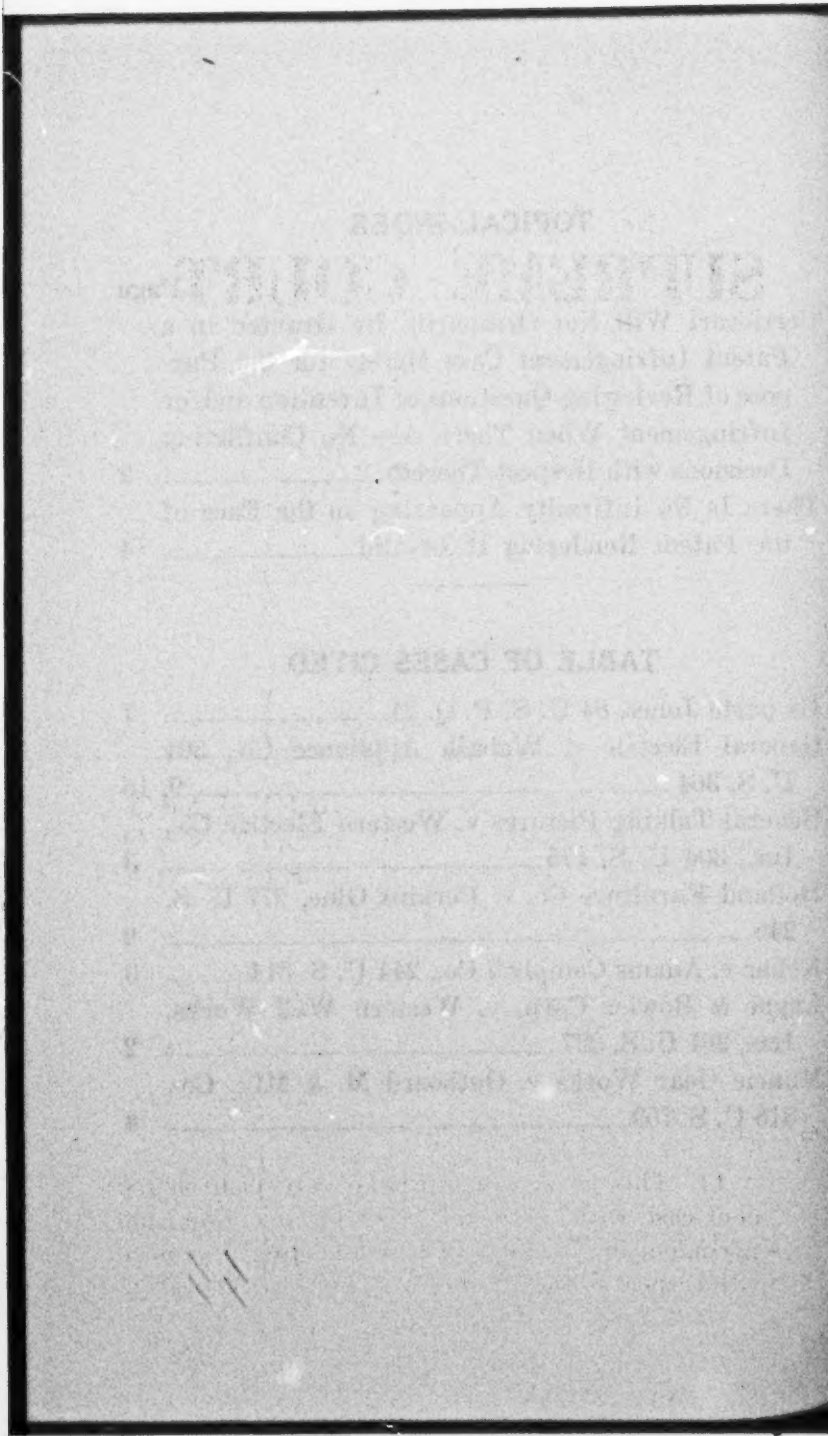

IN THE

SUPREME COURT

OF THE

United States

October Term, 1953

PACIFIC CONTACT LABORATORIES, INC., MORRIS GREEN, and LEE W. HOGGAN, *Petitioners,* vs. SOLEX LABORATORIES, INC., *Respondent.*	No. 735

BRIEF OF RESPONDENT, SOLEX LABORATORIES, INC., IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

To the Honorable the Chief Justice and Associate Justices of the Supreme Court of the United States:

The petition for a writ of certiorari should be denied in this case for the following reasons:

1) This is but an ordinary patent infringement case with the usual issues of invention and infringement. There are no conflicting decisions with respect to these issues by Courts of Appeal in

different circuits requiring reconciliation or resolution by this Court.

2) The issue raised in the petition is an issue which was neither raised nor tried in the Trial Court. While petitioner urges that there is an "infirmity appearing on the face of this patent," (Petition, pg. 4) no such infirmity in fact exists. The claims of the patent in suit do not "define the alleged novelty of the patented article in functional terms of its mode of use" nor "the scope of the patent monopoly in terms of the function of the article." Instead, they define the size and shape of the patented lens with relation to the size and shape of the human eye on which it is to be worn. This size and shape varies with different patients.

CERTIORARI WILL NOT ORDINARILY BE GRANTED IN A PATENT INFRINGEMENT CASE MERELY FOR THE PURPOSE OF REVIEWING QUESTIONS OF INVENTION AND/OR INFRINGEMENT WHEN THERE ARE NO CONFLICTING DECISIONS WITH RESPECT THERETO.

In *Layne & Bowler Corp. v. Western Well Works, Inc.*, 261 U. S. 387, this Court said:

" . . . It is very important that we be consistent in not granting the Writ of Certiorari except in cases involving principles, the settlement of which is of importance to the public as distinguished from that of the parties, and in cases

where there is a real and embarrassing conflict of opinion and authority between the Circuit Courts of Appeal."

In *Keller v. Adams Campbell Co.*, 244 U. S. 314, this Court said:

"Such an ordinary patent case with the usual issues of invention, breadth of claims and non-infringement, this court will not bring here by certiorari, unless it be necessary to reconcile decisions of the Circuit Court of Appeals on the same patent."

Again in *General Talking Pictures v. Western Electric Co., Inc.*, 304 U. S. 175, it is said:

"Granting of the writ would not be warranted merely to review the evidence or inferences drawn from it." . . .

"Nor would the writ be granted to review the questions of anticipation and invention that petitioner argues, for as to them there is no conflict between decisions of the Circuit Courts of Appeals."

THERE IS NO INFIRMITY APPEARING ON THE FACE OF THE PATENT RENDERING IT INVALID

Petitioner urges that there is an infirmity appearing on the face of the patent that justifies review by this Court. Although the issue now raised was not raised in the Trial Court, petitioner relies upon *Muncie Gear Works v. Outboard M. & Mfg. Co.*, 315 U. S. 759. The *Muncie* case is hardly applicable because there the issue of prior public use and sale more than two years before the claims in issue were presented before the Patent Office was indisputable. Evidence of such had been given by "respondent's own officers and witnesses" and had "not been questioned or contradicted and is interpreted by respondent's counsel in accordance with our view of it." Consequently, "there is not the slightest indication that respondents have been prejudiced by such obscurity" with which the issue had been presented in the courts below.

But here, the respondent would be decidedly prejudiced. This issue was not raised in the Trial Court as admitted in the petition, page 3. There was no occasion to raise it because the defendants could not assert that

> "It would be impossible for (them as) a lense manufacturer to know precisely how an optometrist might fit the manufacturer's lense upon a patient." (Pet. page 6.)

The lenses which they supplied pursuant to order made it impossible for the optometrist to fit them otherwise than in an infringing manner.

In the present case the patented lens differs from the prior art *structurally* in two important respects:

1) It did not extend beyond the cornea over onto the sclera; and

2) The radius of curvature on its concave side was slightly greater than the radius of curvature of the cornea of the patient who is to wear the lens.

A concavo-convex lens thus made and ground to correct for visual deficiency of the patient has proven highly successful because

1) No pressure is applied to the sclera as in prior contact lenses which tend to shut off the blood supply to the eye.

2) No buffer solutions are required between the lens and the eye as in the case of prior scleral-type contact lenses.

3) Natural eye fluids produced by the patient himself form a buffer between the lens and the eye that is constantly being replenished and replaced by the patient.

4) Despite the greater radius of curvature on the concave side of the lens than the radius of curvature of the cornea, the lens does not drop out of the eye or slide to the bottom of the eye, but remains centered on the eye in spite of blinking of the eyelids.

Even the defendants, themselves, in their instruction manual, Ex. 13, acknowledged that the patented lens was a definite advance in the art. The following is quoted from that Exhibit:

> "In 1948 Dr. Morris W. Nugent, M.D., of Los Angeles, who had acted as ophthalmologic consultant in the development and trial of corneal lenses which were supplied to him by Mr. Kevin Tuohy of the Solex Laboratories, presented his first report on his experiences with corneal lenses. The results were so impressive and the publicity given was so favorable that a great interest was immediately aroused throughout the country, as well as in foreign lands, for further trial. . . .
>
> "In a second report given by Dr. Nugent in 1949, the larger series of patients who have been successfully fitted has definitely established the corneal contact lens as an invaluable adjunct in the correction of defective vision."

The differences between the patented lens and the prior art are *structurally*—not functionally—set forth in the claims. As set forth in the claims the lens shall be concavo-convex and shall have

> "a marginal size smaller than the limbus portion of the eye to which it is applicable but larger than the maximum iris opening, said lens having a radius of curvature on its concave side slightly greater than the radius of curvature of the cornea to which it is applied so that radially from the center of the lens there will be a small but gradually increasing clearance for the entry of natural

eye fluids between the lens and the cornea, said lens being ground to correct for visual deficiency."

As stated in the petition, page 6,

> "Seldom are two corneas found which are alike in size and curvature . . . "

Also, seldom do the eyes of different patients have the same visual deficiency. It follows that lenses to fit such eyes would seldom be alike in marginal size, radius of curvature, and correction for visual deficiency.

It was consequently necessary to define the *structure* of the patentee's lens by its relationship to the size and curvature of a particular patient's cornea. This size and curvature are constantly varying with different patients.

A claim of structure defined with relation to human anatomy is in accordance with recognized Patent Office practice, see *Ex parte Jones*, 84 U. S. P. Q. 24:

> " . . . The claims were rejected on the grounds that they are deemed informal and indefinite. The basis for this position is that the claims recite the relation of many of the parts to each other through their relation to the patient's head, neck, face, or body . . . We have examined the claims with care and we notice that it is sufficient to define the relation of the various parts if it be assumed that the head and neck of a human being defines a line passing centrally through the head and neck. With this line or axis established for reference, the location of the various parts of applicant's

clamps referred to in the claims may be established. This mode of definition is not as convenient to follow as one which is confined to the geometry of the clamp itself. *However, it has long been the practice in the Patent Office, as will be seen by reference to the patents called to our attention by appellant, to permit devices for application to anatomy to be referred to normal anatomy to assist in defining the orientation of the parts. We cannot say that this is improper.* Admittedly, directions and distances are not precisely determined in this matter (*sic*, probably manner), but this art does not ordinarily require the same precision as the machine tool art for example." (Italics added.)

The defendants here are not lens manufacturers who did not "know precisely how an optometrist might fit the manufacturer's lens upon a patient." (Petition, page 6.) On the contrary, for the express purpose of securing evidence of infringement, Dr. Lionel Lewis, an optometrist, telephoned to the defendants an optometrist's prescription (R. 51) giving the measurements of a patient's eyes. He ordered lenses from the defendants which would meet the requirements of a patient having such measurements. The order was filled by the defendants. These lenses, according to

> "the order form that the (defendant's) laboratory prepared . . . were flatter than the cornea—flatter than the measurements of the cornea with which I had supplied them." (R. 56.)

Had these lenses been applied to the patient, all of the advantages to be derived from the patented lens would necessarily have been obtained. The defendants consequently knew exactly what they were doing. They had been taught (R. 84, 85) and had received instruction from the patentee and those affiliated with him as to the relationship that should exist between the lens and the patient's eye according o the teachings of the patent. They filled Dr. Lionel Lewis' order accordingly. According to the opinion of the Court of Appeals herein (R. 278)

> "Appellants' lens is a 'Chinese' copy of the Tuohy lens."

The claims of the patent structurally define the patentee's lens with relation to the patient's eye—a variable. They do not define the "patented article in functional terms of its mode of use" as alleged in the petition, page 6.

The cases of *General Electric v. Wabash Appliance Co.*, 304 U. S. 364, and *Holland Furniture Co. v. Perkins Glue*, 277 U. S. 245, are not in point. In the *General Electric* case, the attempt was to monopolize all filaments which would neither substantially sag nor offset regardless of how the filaments were made. In the *Holland* case the attempt was to monopolize all starch glues having the characteristics of animal glues. In such attempts functional statements were relied upon to define the differences between the patentee's products and the products of the prior art. In those

cases, the patentees should have defined their products either by the ingredients thereof, the grain structure thereof, or by the processes by which they had been produced. Had the patentees done so, the advantageous results claimed for their products would have inherently followed.

As said by this Court in *General Electric Co. v. Wabash*, supra,

> "A limited use of terms of effect or result which accurately define the essential qualities of a product to one skilled in the art may, in some instances, be permissible and even desirable . . . "

In the present case functional statements of use or result are not relied upon the differentiate the patentee's lens from the prior art. Instead, the size and curvature relationship between the lens and the patient's eye are relied upon. If this size and curvature relationship is established as defined by the claims, the advantageous results of avoiding pressure on the sclera, avoiding the use of artificial or synthetic buffer solutions, and the creation of "a small but gradually increasing clearance for the entry of natural eye fluids between the lens and the cornea" will inherently follow.

There is no other way in which the patentee's lens—a new article of manufacture—could be accurately and structurally defined except by its relationship to the size and curvature of the patient's cornea to which it was to be applied.

It is respectfully submitted that petitioners' contention raised for the first time on appeal is without merit and that the petition should be denied.

Respectfuly submitted,

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Attorney for Respondent,
Solex Laboratories, Inc.